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EXAMINER

HALPERN, MARK

ART UNIT	PAPER NUMBER
1731	11

DATE MAILED: 05/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/009,007	LOKITEK ET AL.
	Examiner Mark Halpern	Art Unit 1731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 15 April 2003.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 28-48 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 28-48 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ .
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .	6) <input type="checkbox"/> Other: _____ .

DETAILED ACTION

- 1) Acknowledgement is made of Amendment received 4/15/2003, Paper No. 10.

Applicants cancel claims 10-27, and offer new claims 28-48, for consideration.

Claim Objections

- 2) Claims 28-48, are objected to because of the following informalities:

In view that claims 10-27, are cancelled and new claims 28-48 are offered for consideration, said new claims are not to be marked up. Marked-up claims apply to amending of existing claims 10-27. Nevertheless, claims 28-48 shall be reviewed.

- 3) Claims 44-48, are objected to because of the following informalities:

Claims 44 may refer to claim 29 or number 29 should be removed from claim.

Claims 46: reference to number 28 should be removed from claim.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

- 4) Claims 46-48, are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to

one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 46 recites limitation "...the mass constituting such a structure and during its formation, use is made in at least one steps of a composition 28 comprising at least one cationic starchy material and at least one sulfonated starchy material.". The originally filed Specification fails to provide for the one step only addition of a cationic starchy material and a sulfonated starchy material. The original claim 26 recited the use of "...one or more steps..." in the addition of the claimed cationic starchy and sulfonated starchy materials. The concept of simultaneous or one step only introduction of a composition comprising cationic and anionic starches as introduced in claim 46 is considered new matter.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

- 5) Claims 44-45, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 44 does not set forth a positive process step thus properly defining a process.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6) Claims 28-45, are rejected under 35 U.S.C. 102(b) as being anticipated by Gosset (5,129,989).

Claims 28-30, 44-45: Gosset discloses a process for manufacturing paper (Abstract). A composition of cationic starches (col. 4, lines 23-64) and starch sulfocarboxyls, such as, 3-chloro-2-sulfo-propionic acid, is added in the process. The total amount of cationic and sulfonated starch added to the paper product is from 0.4 to 10 % (col. 3, lines 34-39). Also disclosed is a compound sodium monochloracetate (col. 5, lines 4-23).

Claims 31-33: a weight ratio of cationic to sulfonated starches of 10/1 to 1/10 is disclosed (col. 3, line 64 to col. 4, line 2).

Claims 34-35: the composition is a solid mixture in the form of a powder (col. 3, line 62).

Claims 36-37: the composition is an aqueous suspension (col. 3, line 60-62).

Claims 38-41: the composition is introduced in the form of aqueous size (col. 3, lines 45-49).

Claims 42-43: one of the starchy materials is cereal, corn starch (col. 5, lines 53-60).

Response to Amendment

- 7) Claims 25-27, objection is withdrawn in view of cancelled claims.
- 8) Claims 10-27, rejection under 35 U.S.C. 112, second paragraph, is withdrawn in view of cancelled claims and submittal of amended claims.
- 9) Applicant's arguments filed 4/15/2003, have been fully considered but they are not persuasive.

Applicants arguments presented in regards to claims 10-27, are moot since said claims are cancelled.

Applicants allege that the cited prior art, Gosset, does not disclose a simultaneous introduction of a composition comprising cationic and anionic starches, that the Gosset reference recites the introduction of the starches separately from one another.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the concept of simultaneous introduction of a composition comprising cationic and anionic starches) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicants allege that the levels and quality of starches addition in the present invention is superior over the addition of starches in the cited reference, Gosset.

Examiner responds that the Gosset reference discloses the addition of claimed starches.

Conclusion

10) Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11) Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Halpern whose telephone number is 703-305-4522. The examiner can normally be reached on Mon-Fri, (9:00-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on 703-308-1164. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7718 for regular communications and 703-305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.

MH

Mark Halpern
Patent Examiner
Art Unit 1731

May 21, 2003

Steven P. Griffin
STEVEN P. GRIFFIN
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